

PATENT

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Signature

Appl No.	: 10/750,497	Confirmation No. 1796
Applicant	: Kristine B. Fuimano, et al.	
Filed	: December 31, 2003	
Title	: IRRIGATION PROBE FOR ABLATION DURING OPEN HEART SURGERY	
TC/A.U.	: 3763	
Examiner	: Laura A. Bouchelle	
Docket No.	: 51678/W112	
Customer No.	: 23363	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Post Office Box 7068
Pasadena, CA 91109-7068
May 28, 2008

Commissioner:

Applicant requests review of the continued rejection of claims 1-30 in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. The review is requested for the reasons stated below.

In maintaining the rejections of claims 1-30 under 35 U.S.C. §102(a) as anticipated by Pomeranz, et al. (U.S. Patent No. 5,800,482) and under 35 U.S.C. §103(a) as obvious over Pomeranz, the Examiner argues that "[t]he probe body of Pomeranz is generally rigid because it does not lose its shape under force," and that "the probe body is rigid enough to resist kinking or collapse when inserted into the patient." December 28, 2007 Final rejection, page 3. However, as noted in Applicant's response filed October 1, 2007, Pomeranz repeatedly emphasizes that the catheter is maneuverable through the vasculature of the heart. See column 4, lines 46-49; column 7, lines 18-20; column 8, lines 33-36; column 10, lines 19-23; column 12, lines 22-25;

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column 13, lines 13-18; column 14, lines 14-18; and column 15, lines 1-3 (describing the insertion of the catheter through the vessels of the patient to reach endocardial tissue). To achieve this maneuverability through the vessels of the patient and the vasculature of the heart, the Pomeranz device is necessarily bendable and flexible in order to navigate through the patient's vessels to reach endocardial tissue. To navigate through the vessels and vasculature, a force is applied to the device, in response to which the catheter bends and flexes in order to steer through the vessels and vasculature. As such, the Pomeranz device does in fact "lose its shape under force," contrary to the Examiner's assertion. Also, although the Pomeranz device may include some favorable torque characteristics that make it easier to maneuver through the patient's vessels and heart, and these characteristics may help the device to "resist kinking or collapse when inserted into the patient," these characteristics do not render the device "generally rigid," as recited in the present claims.

"Rigid" is defined in Merriam Webster's Collegiate Dictionary, Tenth Edition (1995) as "deficient in or devoid of flexibility" or as "appearing stiff and unyielding." Given this definition, the Pomeranz device clearly is not generally rigid. As noted above, the Pomeranz device is necessarily flexible to enable manipulation through the vessels and vasculature of the patient. Since the Pomeranz device is necessarily flexible, it cannot be "deficient in or devoid of flexibility" or appear "stiff and unyielding." Accordingly, the Pomeranz device is not generally rigid, as recited in the present claims.

To the extent the Examiner argues that the Pomeranz device is inherently rigid, Applicant respectfully traverses the argument. To establish inherency, the missing descriptive matter must be "necessarily present in the thing described in the reference." *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999)(quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991))("Robertson"). As noted above, the Pomeranz device is not *necessarily* rigid. Quite to the contrary, the Pomeranz device is necessarily *flexible*. As such, the Pomeranz device is not inherently rigid. Accordingly, independent claims 1, 5, 17 and 22 reciting a generally rigid probe body, and all claims dependent therefrom, including claims 3, 4, 6, 9, 11-14, 18-21 and 23-30, are allowable over

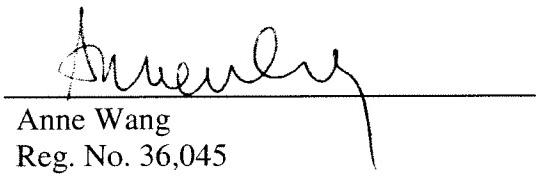
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Pomeranz. Applicant therefore respectfully requests reconsideration of the rejection of the pending claims.

Respectfully submitted,

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